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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IBRAHIM M. SEZAN, RICHARD QIAN, and
PETER J.L. VAN BEEK

Appeal 2009-000771
Application 09/804,612
Technology Center 2100

Before JAMES D. THOMAS, THU A. DANG, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants request rehearing of our Decision (“Decision”), in which we affirmed the rejection of claims 2-23 as being unpatentable over Oosterhout and Yoshida and the rejection of claim 24 as being unpatentable over Oosterhout, Yoshida, and Brown.

ANALYSIS

In their Request for Rehearing, Appellants allege that (1) “the decision on appeal failed to respond to several of the App[ellants] arguments of record, and in doing so failed to articulate a cogent explanation of obviousness that is required to support a rejection under 35 U.S.C. § 103(a)” (Req. 4); (2) the Examiner’s response is “an improper ‘bait and switch’ because [] what the Examiner contends is preference data as taught by Oosterhout is completely different than the preference data as allegedly taught by Yoshida” (Req. 7); (3) “any obviousness rejection needs an explanation as to why that combination would be obvious, and neither the Examiner nor the Board has provided that explanation” (Req. 7); (4) “[t]here is no support in the specification for reading of the App[ellants’] claimed ‘user description scheme’ and its ‘user preference data indicative of expected content preferences’ on a parental lock feature that *blocks* content absent manual entry of a password so as to prevent *others* from watching predefined content” (Req. 10.); and (5) “the Board has improperly construed the term ‘without user input’ by depriving that term of any meaning, essentially reading it out of the claim” (Req. 13).

Regarding (1), Appellants argue that “the limitation [i.e., user preference data . . . indicative of expected content preferences] could not be read upon either Yoshida alone, or *in combination* with Oosterhout. The Board’s decision failed to address any of these issues.” (Req. 6.) We disagree with Appellants.

Specifically, in our Decision, we address this limitation by finding that *both* Yoshida and Oosterhout reasonably teach “expected content preferences.” (Decision 6.) For example, we found that “[b]ecause the parent’s password in Yoshida prevents access to inappropriate content, expected content follows for a predetermined user. As such, . . . expected content preferences *reads on* at least Yoshida’s parental control features. In addition, Oosterhout discloses that a user can select a ‘theme.’” (*Id.*) In other words, our Decision clearly illustrated that both cited references, Yoshida and Oosterhout, suggest using “user preferences” and obtaining “expected content” based on such preferences. Thus, Appellants’ argument (1) is unpersuasive.

Regarding (2), Appellants argue that the Examiner has performed an improper “bait and switch.” We view this contention as alleging “new reasoning” (i.e., a new ground) in the Final Rejection, which was reiterated in the Answer. If Appellants believed that the new reasoning changed the basis of the rejection so as to make, in effect, a new ground of rejection, they could have filed a timely petition under § 1.181 to reopen the prosecution of the subject application. *See* MPEP § 1207.03 (IV)(8th ed., rev. 7, July 2008). Whether a rejection on appeal constitutes a new ground of rejection is reviewed by way of petition, *not* appeal.

Regarding (3), Appellants contend that no explanation was provided for the obviousness rejection (Req. 7). We disagree. For example, the Examiner stated in the Answer that “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the password setup of Yoshida in the television program of Oosterhout to prevent children from accessing inappropriate scenes or channels.” (Ans. 5.) The Examiner further found that “both Oosterhout and Yoshida are in the same field of [] invention because they deal with television/video programming.” (Ans. 13.)

Appellants’ arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner’s prima facie case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981)(“*The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.*”)(citations omitted, emphasis added). This reasoning is applicable here.

In this case, the Examiner properly demonstrated that the combined teachings would have suggested to those of ordinary skill in the art a television programming system that could include a password setup as taught in Yoshida. It is not necessary for the Examiner to explain how the combination of references would operate. Thus, we find that Appellants have not demonstrated any lack of explanation or an error in the Examiner’s combination of the references to form the claimed invention.

Regarding (4), Appellants contend that there is no support in Appellants' Specification for reading the claimed "user description scheme" on Yoshida's parental lock feature. We disagree.

In our Decision, we broadly but reasonably construed the claimed "expected content" (which relates to the user description scheme) as denoting any content that is believed to be provided (Decision 5). We broadly but reasonably applied this construction because Appellants' Specification does not provide an explicit definition for the claimed "user description scheme," but rather gives *examples* of what it *may* include. (*See* Spec., 10-11.) Although giving claims their broadest reasonable interpretation must take into account any definitions given in the Specification, *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), it is improper to read into the claims limitations from *examples* given in the Specification. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989)(emphasis added). Absent claim language carrying a narrow meaning, we only limit the claim based on the specification when sources expressly disclaim the broader definition. *In re Bigio*, 381 F.3d 1320, 1324-25 (Fed. Cir. 2004).

Here, there is no claim language, in claim 21, which carry any narrowing definition for the recited "user description scheme" and the Specification does not provide an explicit definition. All that is required in the claim is that it contains "user preference data" for a predetermined user and a descriptor for the predetermined user (*see* Claim 21). Yoshida discloses a program lock feature for restricting data using a password known only by the child's parents. (Decision, FF 1a-1c.) In other words, Yoshida's program lock feature allows the user to restrict inappropriate video scenes (i.e., preference data) by using a password related to a predetermined user.

As such, Yoshida expects to receive content that is appropriate for children. We also point out that the claimed “user” can be an individual, a resident, a family, an organization, etc. There are no requirements attached to the claimed “user” other than to have a descriptor. Here, Yoshida’s user, e.g., a parent and child (e.g., a family), has a password (i.e., a descriptor). Therefore, we find that Yoshida’s program lock feature is consistent with many of Appellants’ “user description scheme” examples, such as the user’s personal preferences (i.e., to avoid inappropriate content), filtering history (i.e., password filtering out inappropriate content), device setting history (i.e., use of a password). (*See* Spec. 10.) Specifically, Appellants’ Specification states that a user description scheme can be compared with the *program’s intended audience* profile and a determination can be made on whether it matches that of the user (Spec. 11:21-24). Thus, Appellants’ own Specification considers intended audience appropriateness when selecting programs for a user, which is similar to Yoshida’s parental lock features.

Therefore, we find that Appellants have not demonstrated that Yoshida’s lock feature is inconsistent with Appellants’ Specification.

Regarding (5), Appellants contend that “the Board has improperly construed the term ‘without user input’ by depriving that term of any meaning, essentially reading it out of the claim” (Req. 13). We disagree.

Claim 21 recites, *inter alia*, “an electronic device selecting without user input at least one of a video, . . .” In our Decision, we found that Oosterhout’s next button allows the user to “see” the next result, while Oosterhout’s microprocessor sub-program automatically “selects” the next video from the EPG to perceptibly display based on the theme previously

selected by the user (Decision 7). In other words, it is the “selecting” of video that claim 21 requires to be done “without user input.” Oosterhout’s microprocessor sub-program performs this video selection function using preferences previously inputted by the user (*see* Decision, FFs 2a-2b). As conceded by Appellants, “the processor . . . by its nature *always* automatically perform the final step of implementing some manual input” (Req. 13). Therefore, we find that Appellants have not demonstrated that the Board improperly construed the term “an electronic device selecting without user input.”

DECISION

Accordingly, we have granted Appellants’ Request to the extent that we have reconsidered the original Decision but have DENIED it with respect to making any changes to the Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

rwk

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